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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,884	04/20/2001	Rudolf Hans Aebersold	64-98A	4321

23713 7590 02/09/2004

GREENLEE WINNER AND SULLIVAN P C
5370 MANHATTAN CIRCLE
SUITE 201
BOULDER, CO 80303

EXAMINER

GABEL, GAILENE

ART UNIT PAPER NUMBER

1641

DATE MAILED: 02/09/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/839,884

Applicant(s)

AEBERSOLD ET AL.

Examiner

Gailene R. Gabel

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Amendment Entry

1. Applicant's amendment and response filed 8/23/02, in Paper No. 7, is acknowledged and has been entered. Claims 1, 6, 8, 13, and 15-18 have been amended. Currently, claims 1-28 are pending and are under examination.

Rejection Withdrawn

2. In light of Applicant's amendment, the rejection of claims 1-28 under 35 U.S.C. 112, second paragraph, as being indefinite, is hereby, withdrawn.

3. In light of Applicant's amendment and argument, the rejection of claims 1-7, 9-10, 12-16, 18-20 and 22-28 under 35 U.S.C. 103(a) as being unpatentable over Sigler et al. (US 4,798,795) in view of Duncan et al. (Analytical Chemistry, March 1998), is hereby, withdrawn.

4. In light of Applicant's amendment and argument, the rejections of claims 8, 11, 17, and 21 under 35 U.S.C. 103(a) as being unpatentable over Sigler et al. (US 4,798,795) in view of Duncan et al. (Analytical Chemistry, 3/1998) as applied to claims 1-7, 9-10, 12-16, 18-20 and 22-28 above, and further in view of Allen et al. (US 5,438,017) and also Markert-Hahn et al. (US 5,514,559), are hereby, withdrawn.

New Grounds of Rejection

Double Patenting

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 12, 20, 21, 24-37, 41, 42, 46-51, 53, 54, 56-63, 68-71, 75-78, 80-82, and 84-95 of U. S. Patent No. 6,670,194. Although the conflicting claims are not identical, they are not patentably distinct from each other because US Patent No. 6,670,194 recites and defines claims drawn to a reagent, as claimed. See especially claim 24 and 93. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use and incorporate the reagent in instant claims 1-28 into the method of identifying and determining the relative amounts of proteins as taught by US Patent No. 6,670,194 because the reagent used in US Patent No. 6,670,194 is identical to that in the recited claims.

6. Claims 22-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 12, 20, 21, 24-37, 41, 42,

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46-51, 53, 54, 56-63, 68-71, 75-78, 80-82, and 84-95 of U. S. Patent No. 6,670,194 in view of Foster (US Patent 4,444,879).

US Patent 6,670,194 differs from the instant invention in failing to disclose incorporating the reagent into a kit format.

Foster teaches reagents, labels, instructions for use, thereof, in a kit format

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to incorporate the reagent and labels taught by US Patent 6,670,194 into a kit arrangement as taught by Foster because test kits are conventional and well known in the art for their recognized advantages of convenience and economy.

7. No claims are allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gailene R. Gabel whose telephone number is (703) 305-0807. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gailene R. Gabel

Patent Examiner

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February 3, 2004 *gb*

Long
LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

02/04/05